



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,171	08/16/2000	Yoshihiro Tsukamura	SON-1889	4002

23353 7590 05/09/2003

RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER
----------

HESELTIME, RYAN J

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 05/09/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/639,171

Applicant(s)

TSUKAMURA ET AL.

Examiner

Ryan J Hesseltine

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

2. Upon review of a translation of the priority application 11-231683 filed in Japan on August 18, 1999, obtained from the Japanese Patent Office Patent Abstracts website, it has become aware to the examiner that perhaps a word integral to the invention has been improperly translated. The instant invention claims creating "read hysteresis information indicating that said read fingerprint information has been created" (claim 1, line 5-7), whereas the translation claims and discloses "read *history* information" (emphasis added). A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear what applicant

Art Unit: 2623

means by "read hysteresis information" (see above discussion of the suggested translation problem).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumura (USPN 5,493,621) in view of Hirakawa et al. (USPN 5,664,126), hereafter Hirakawa.

7. Regarding claims 1 and 4, Matsumura discloses a fingerprint collating device and method for collating a user's fingerprint with registered fingerprint information to effect personal authentication (column 3, line 38-42), said device and method comprising: fingerprint reader (11) for reading said fingerprint to create read fingerprint information (column 3, line 43-54), and to create read hysteresis information indicating that said read fingerprint information has been created (column 4, line 9-13); and collator for collating (comparing) said read fingerprint information with said registered fingerprint information (column 7, line 25-30) to effect personal authentication and output a result of authentication (column 4, line 6-11).

8. Matsumura does not disclose how the read hysteresis management is performed. Hirakawa discloses a human interface system for communicating networked users wherein each user (having personal person information including name and ID) holds information called site hysteresis information which is a combination of the virtual site's name and ID and contains hysteresis of the sites the person has visited (column 17, line 35-47). Hirakawa goes on to

Art Unit: 2623

disclose collating hysteresis information in order to determine if the user has visited that site before (column 45, line 41-55), including hysteresis storage section 841 (column 46, line 10-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store read hysteresis information and output a comparison result as taught by Hirakawa in order to determine whether a user has previously visited a site or requested retrieval of certain information (column 46, line 42-58).

9. Regarding claim 2, Matsumura discloses that said collator effects said personal authentication by using said registered fingerprint information supplied from external (image input device 11; column 10, line 60-65).

10. Regarding claim 3, Matsumura discloses registered fingerprint information storage (memory 41) for storing said registered fingerprint information, in which said collator effects said personal authentication by using said registered fingerprint information stored in said registered fingerprint information storage (column 3, line 43-54).

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 4,650,978 to Hudson et al. discloses an offline cash card system and method including a magnetic hysteresis security arrangement. USPN 6,438,257 to Morimura et al. discloses a small capacitance change detection device including hysteresis in a detection threshold to account for noise variations. USPN 3,533,823 to Newkirk et al. discloses a method of making a facsimile of a skin friction-ridge pattern using a material having hysteresis characteristics. USPN 5,618,232 to Martin discloses a dual mode gaming device method and system including a touch screen that senses finger location using hysteresis.

Art Unit: 2623

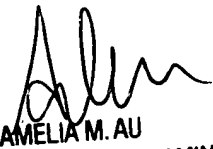
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069.

The examiner can normally be reached on Monday - Friday, 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

rjh  
May 5, 2003

  
AMELIA M. AU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600